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EXAMINER

CHAVIS, JOHN Q

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/718,885	Applicant(s) HOBERMAN, GARY A.	
	Examiner John Chavis	Art Unit 2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/17/07 & 8/4/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8-13 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8-13 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. The applicant indicate that the claims (10-12 and 22-23) are statutory; however, the rejection below clearly indicate why they are not statutory. That is, the office no longer considers claims directed toward waves as statutory; since they are considered to represent a form of energy. Also, software claims are considered non statutory. The applicant's means for performing, in the system claims, are considered merely software components. Also, it is not clear that the computer readable medium (since it is not clear where this feature is defined in the specifications) is anything other than the applicant's claimed "signal" (which is not a physical disk). Therefore, since the rejection stands, the previous rejection is hereby repeated below.

3. The claimed invention is directed to non-statutory subject matter. The claimed invention in claims **10, 11, 12, 22, 23** are non-statutory; since, it is claimed as transmitted code (**see specifically claims 11 and 22**). Patentable subject matter of this type would be stored on a computer **storage** readable medium (a manufactured item, **such as claim 23**), a method (process) comprising specific computer implemented steps or a means for executing (machine) the specific steps of each method. The claimed "transmitted code" (**specified in claims 11 and 22**) is not considered to fit into either of the statutory classes indicated above. **Furthermore, claim 10 claims a**

system; however, nothing in the claim appears to indicate a specific hardware component of a system. The applicant claims various means; however, nothing in the claims indicate that the claims are anything other than software. Claim 10 can be fixed by adding “a processor with” after “comprising” on line 2.

Claims 12 and 23, on the surface, appear to be statutory; however, it is not clear that the applicant’s computer readable medium is anything other than his intended “transmission media” (utilized for software code transmitted as an information signal). Therefore, the claims are non-statutory.

The current focus of the Patent Office in regard to statutory inventions under 35 U.S.C. § 101 for method claims and claims that recite a judicial exception (software) is that the claimed invention recite a practical application. Practical application can be provided by a physical transformation or a useful, concrete and tangible result. No physical transformation is recited and additionally, the final result of claims 11 and 22 is the transmission of code, claim 10 is considered a system of software components and claims 12 and 23 are considered a computer readable medium that does not exclude a transmission medium, which are not a tangible result because the code alone in claims 11 and 22 is non functional and not stored on a computer storage medium. Claims 12 and 23 also consists of code and is not stored on a computer storage medium and the system of claim 10 is considered merely software means that is not specifically tied to components of a computer system.

Claim Rejections - 35 USC § 102

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 8-13 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Rodrigues et al. (6,067,639).

Claims

1. A method for software application development, ...the method comprising: characterizing the file format and data structure of at least one known input file type; and

creating a library comprising a plurality of jobs,

configured to perform a predetermined function ...

Wherein the library of jobs comprises
At least one job configured to read...
And convert...

Extract...

Archive...

Rodrigues

See the title, abstract and col. 3 lines 25-29. The feature of suitable for processing makes it appear that no function is performed. It makes it appear that the system is merely (capable) of performing some function; while, it is standard for working applications to be capable for performing some function. Rodrigues' system and method is also considered capable of performing some function.

See col. 3 lines 29-35.

see col. 3 lines 51-65 and col. 2 lines 4-11. This feature is also considered merely capable to perform a function.

notice these features are merely configured to do something (they do not actually perform a function Which is expected for a method. However, see the convert reply below. See col. 3 line 33-39. **This feature is considered merely to assist with testing, also see col. 4 lines 34-44.**

See col. 4 lines 27-33. **In reference to this feature, see also col. 4 lines 37-**

	44 as specified in claim 1 for Playback files. See col. 9 lines 26-31.
Load...	
Messaging...	See col. 13 lines 37-45, col. 14 lines 15-19, col. 14 lines 35-40 and col. 17 lines 53-64.
Transforming..	See the information above and col. 9 lines 18-28.
Validating...	see col. 6 lines 10-19. The applicant claims that his system discloses validating of data in a file by one of The jobs in a library; however, no such feature exists here. The feature merely specifies that a job is configured for (capable of) validating. Nothing is ever validated. However, the applicant claims his validation is via jobs, while, further details of Rodrigues validation is via Scripts (jobs), see col. 6 lines 53-67.'
including an indicator of job termination, wherein the indicator is either termination success or termination failure, and	
the plurality of jobs are configured for linking according to the indicator, with at least one of the jobs configured to read the file format and data structure of the known input file	" " " "
and convert that input file to a tab delimited format or data structure...	See col. 4 lines 16-36, which specifically addresses porting to different environments (i.e converting). Rodrigues indicates that

“The test tools can be readily available in any computing environment to which the development staff chooses to port the application program. In addition, the test tools of the present invention, unlike scripting and macro methods of the past, do not require the development or testing teams to port the test cases between the various computing environments on which the program is to be tested. The test tools of the present invention are available for all platforms on which the application program may be run. The test suites are recorded in a portable manner by the test tools of the present invention in so-called playback files, see also lines 37-44 of col. 4.

The applicant indicates that he finds no conversions performed by Rodrigues; however, the abstract indicates that it provides for “simulating” required data or file, which provides for converting, see any standard dictionary. Note also the problem of communicating in different environments that Rodrigues addresses via col. 2 lines 12-30

The feature of converting to a substantially common format is considered the main reason for performing conversions to enable compatibility and this feature is considered inherent in Rodrigues’ system to enable porting of cases between various environments.

Rodrigues’ porting for a different environment is considered the same as converting files from one format to another; since this is the definition of porting.

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further comprising: creating a job stream library, the job stream library comprising at least one job stream, the job stream comprising individual jobs from the library of jobs, and the at least one job stream in the job stream library including an indicator of job termination, wherein the indicator is either termination success or termination failure.

9. A method according to claim 1, further comprising adding jobs to the library of jobs.

See claim 12 of '639.

Claims 10-13 are rejected as claim 1. **The applicant claims that claim 14 is about processing; however, the actual features (specifically in claim 14) contain no more processing than specified in claims 21-24. The applicant should note that when significant differences are enabled by the claims, restriction is proper.**

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rodrigues in view of the applicant's choice of **selecting the delivery method of data**

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(this feature is still considered merely a choice of design of merely selecting from one of the available options to transmit data).

While Rodrigues does not specifically mention receiving the data file as an email attachment (although he provides for porting to different environments), the feature is considered a choice of design and merely a selection not related to the development of the software application. Rodrigues also does not provide for checking security access; however, the feature would have been obvious to a person having ordinary skill in the art at the time of the invention to ensure the files are transmitted to authorized users.

Rodrigues also does not teach the feature of utilizing a visual interlinking of jobs (claim 19); however, the feature would have been obvious to a person having ordinary skill in the art at the time of the invention to show the user how jobs are linked to simplify the development process and enable easy modification of existing processes. Rodrigues also does not indicate that a specific programming language (claim 20) is utilized; however, it would have been obvious to a person of ordinary skill in the art at the time of the invention that some programming language has to be used and to merely select a specific programming language to take advantage of its specific features, such as ease of use, compatible with most systems and simplifying the process of transmitting to other systems (such as via email).

Rodrigues teach each of the features of claims 21-24 except the manager feature; however, in the following locations certain management functions exist, see col. 4 lines 45-51 and col. 6 lines 53-67 and col. 15 lines 47-51. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to enable

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management functions to be created along with the developed software to ensure compatibility and to enable control and testing of the specific functions created during development.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Chavis whose telephone number is (571) 272-3720. The examiner can normally be reached on M-F, 9:00am-5:30pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis Bullock can be reached on (571) 272-3759. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JC/

/John Chavis/
Primary Examiner AU-2193